

REMARKS

Claims 1-13 have been canceled. Claims 17, 19 and 22, and amended claims 14-16, 18, 20, and 21 are in this application.

Claims 14-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mullo and Asai.

Independent claim 14, as presented herein, recites in part as follows:

"a recordable portion having user's access authorization data which includes information pertaining to a license involving said software program,

wherein said software program storage medium is one of a compact disc, a digital versatile disc, a magneto-optical disc, or a semi-conductor memory type portable storage medium so that said software program and said user's access authorization data are stored on the portable storage medium."
(Emphasis added.)

Accordingly, in claim 14, a software program and user's access authorization data which includes information pertaining to a license involving the software program are stored on a storage medium. Such storage medium is one of a compact disc, a digital versatile disc, a magneto-optical disc, or a semi-conductor memory type portable storage medium. As such, the software program and the user's access authorization data are stored on the portable storage medium.

It is respectfully submitted that neither Mullo nor Asai as applied by the Examiner disclose the above identified feature of claim 1. As an example, neither Mullo nor Asai disclose "said software program and said user's access authorization data are stored on the portable storage medium," as specifically recited in claim 14. In support thereof, and

with regard to Mullor, the Examiner appears to acknowledge that Mullor does not teach "portable storage medium." (See Page 2 of the present Office Action.) As a result, Mullor does not teach "said software program and said user's access authorization data are stored on the portable storage medium," as specifically recited in claim 14. With regard to Asai, the Examiner appears to rely on Figure 1 of Asai and, in particular, elements 14 and 16b thereof. It is respectfully submitted that although Figure 1 of Asai appears to illustrate a CD ROM disk 10 having a recording region 14 and a security code 16b, such portion of Asai does not appear to disclose "said software program and said user's access authorization data are stored on the portable storage medium" in which the user's access authorization data "includes information pertaining to a license involving said software program" as specifically recited in claim 14.

Therefore, neither Mullor nor the portion of Asai relied upon by the Examiner appears to disclose "said software program and said user's access authorization data are stored on the portable storage medium" in which the user's access authorization data "includes information pertaining to a license involving said software program" as specifically recited in claim 14.

With regard to modifying the teachings of Mullor and Asai, reference is made to *In re Fritch*, 23 USPQ 2d 1780 (CAFC 1992), in which the Court states at page 1783:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so'. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a

purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification....It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". (Emphasis ours.)

The Examiner does not appear to have identified any portions in Mullor or Asai which teach or suggest the modifications proposed by the Examiner.

Therefore, it is respectfully requested that the above rejection of claim 14 be withdrawn. For reasons similar to those previously described with regard to claim 14, it is also respectfully requested that the above rejection of independent claims 18 and 20 be withdrawn.

Claims 15-17, 19, and 21-22 are dependent from one of independent claims 14, 18, and 20. Accordingly, it is also respectfully requested that the above rejection of claims 15-17, 19, and 21-22 be withdrawn.

Further, in the present Office Action, the Examiner stated that with regard to claims 15-17, 19, and 21-22, the features of these claims "are well known in the art" and that the Applicant in responding to the previous Office Action "appears not to have disputed this fact." In response, the Applicant does not acknowledge that the features of such claims are well known in the art.

As it is believed that all of the rejections set forth in the Official Action have been overcome, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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